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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/827,489	04/06/2001	Jarmo Makela	297-006914-US (C01)	5743

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EXAMINER
HOOSAIN, ALLAN

ART UNIT	PAPER NUMBER
2645	7

DATE MAILED: 07/28/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/827,489	MAKELA ET AL.	
	Examiner	Art Unit	
	Allan Hoosain	2645	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *13 May 2003* .

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-40* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☐ Claim(s) *1,4-9,12-21 and 23-40* is/are rejected.

7)☒ Claim(s) *2,3,10,11 and 22* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Specification

1. The abstract of the disclosure is objected to because it has "(57)" and "Figure 1" entries. It is not clear that these entries are part of the Abstract. Correction is required. See MPEP § 608.01(b).

2. The Specification is objected to because of the following informalities: The Specification does not have sub-headings. Appropriate correction is required.

The following guidelines illustrate the preferred layout for the specification of a utility application. These guidelines are suggested for the applicant's use.

Arrangement of the Specification

As provided in 37 CFR 1.77(b), the specification of a utility application should include the following sections in order. Each of the lettered items should appear in upper case, without underlining or bold type, as a section heading. If no text follows the section heading, the phrase "Not Applicable" should follow the section heading:

(a) TITLE OF THE INVENTION.
(b) CROSS-REFERENCE TO RELATED APPLICATIONS.
(c) STATEMENT REGARDING FEDERALLY SPONSORED RESEARCH OR DEVELOPMENT.
(d) INCORPORATION-BY-REFERENCE OF MATERIAL SUBMITTED ON A COMPACT DISC (See 37 CFR 1.52(e)(5) and MPEP 608.05. Computer program listings (37 CFR 1.96(c)), "Sequence Listings" (37 CFR 1.821(c)), and tables having more than 50 pages of text are permitted to be submitted on compact discs.) or
REFERENCE TO A "MICROFICHE APPENDIX" (See MPEP § 608.05(a). "Microfiche Appendices" were accepted by the Office until March 1, 2001.)
(e) BACKGROUND OF THE INVENTION.
(1) Field of the Invention.
(2) Description of Related Art including information disclosed under 37 CFR 1.97 and 1.98.

(f) BRIEF SUMMARY OF THE INVENTION.
(g) BRIEF DESCRIPTION OF THE SEVERAL VIEWS OF THE DRAWING(S).
(h) DETAILED DESCRIPTION OF THE INVENTION.
(i) CLAIM OR CLAIMS (commencing on a separate sheet).
(j) ABSTRACT OF THE DISCLOSURE (commencing on a separate sheet).
(k) SEQUENCE LISTING (See MPEP § 2424 and 37 CFR 1.821-1.825. A "Sequence Listing" is required on paper if the application discloses a nucleotide or amino acid sequence as defined in 37 CFR 1.821(a) and if the required "Sequence Listing" is not submitted as an electronic document on compact disc).

Allowable Subject Matter

3. Claims 2-3, 10-11 and 22 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Double Patenting

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground

provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 1-40 are rejected under the judicially created doctrine of double patenting over claims 1-32 of U. S. 6,301,338 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows:

US 6,301,338, recites limitations which are substantially the same even though broader in scope than as recited in the claims of the instant Application. For example, US 6,301,338, Claim 1, recites the types of reply messages which are not in the independent claims of the instant application but is claimed in dependent claims of the instant application.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

DETAILED ACTION

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1,4-9, 12-13,15-21 and 23-40 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by **Wolff et al**. (US 5,327,486).

As to Claims 1,20,23-25,29,33 and 37, with respect to Figures 1-7, **Wolff** teaches a method for replying to a call coming to a portable terminal wherein, in response to the incoming call, the portable terminal identifies the caller on the basis of an identification information, or directs the incoming call to another answering service, said reply having a form selectable from a plurality of forms of communication, and wherein said step of identifying the caller is accomplished by said portable terminal, and said step of sending a reply is accomplished by said portable terminal, said portable terminal being capable of performing said step of sending a reply by providing a selected response to said caller exclusively through the action of said portable terminal (Figures 4,8 and Col. 7, lines 42-46).

As to Claim 4, **Wolff** teaches a method in accordance with claim 1, wherein in response to an incoming call, the portable terminal alarms, and if a user gives a certain key command, the portable terminal sends said reply (Col. 5, lines 24-37).

As to Claim 5, **Wolff** teaches a method in accordance with claim 3, wherein the portable terminal gives a soundless alarm (Col. 7, lines 42-47).

As to Claim 6, **Wolff** teaches a method in accordance with claim 2, wherein the portable terminal routes said call additionally to a usual call answering machine (Col. 5, lines 41-43).

As to Claim 7, **Wolff** teaches a method in accordance with claim 1, wherein said reply is at least partly formulated based on the identification of the calling party (Col. 5, lines 57-65).

As to Claim 8, **Wolff** teaches a method in accordance with claim 7 wherein a reply is sent to certain identified calling parties only (Figure 4).

As to Claim 9, **Wolff** teaches a method in accordance with claim 7, wherein the reply to be sent in response to the incoming call is different according to the respective company said call is coming from (Figures 8 and 10-11).

As to Claims 12-13, **Wolff** teaches a method in accordance with claim 7, wherein said identification of the calling party is based on a telephone notebook comprised by the communication (Col. 5, lines 52-56).

As to Claims 15-18, **Wolff** teaches a method in accordance claim 1, wherein said reply includes time information (Figures 8-9).

As to Claim 19, **Wolff** teaches a method in accordance with claim 15, wherein when the time until the time expressed by said time information has expired, the function controlling the sending of replies in the portable terminal in response to an incoming call is automatically disconnected (Col. 8, lines 29-40).

As to Claims 21,26,30,34,38, **Wolff** teaches a portable terminal in accordance with claim 20, further comprising a real time clock and means for including time information in said reply, said forms of communication including a voice message, e-mail message, facsimile, or SMS message (Col. 5, lines 38-40).

As to Claims 27-28,31-32,35-36,39-40, **Wolff** teaches a method according to claim 25, wherein said step of taking response action comprises selecting a response action to be taken on the basis of a previously made preselection by a user of the portable terminal (Col. 6, lines 41-45).

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

9. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

10. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over **Wolff** in view of **Villa-Real** (US 4,481382).

As to Claim 14, **Wolff** teaches a method in accordance with claim 7:

Wolff does not teach the following limitation:

> "wherein a reminder to call the identified calling party will be stored into the portable terminal, in order to be presented to a user later"

However, it is obvious that **Wolff** suggests the limitation. This is because **Wolff** teaches response messages for calling back callers (Figure 9). **Villa-Real** teaches reminder messages

(Col. 1, lines 50-63). Having the cited art at the time the invention was made, it would have been obvious to one of ordinary skill in the art to add reminder capability to **Wolff's** invention for alerting users as taught by **Villa-Real's** invention in order to provide reminders to users when calls become due.

Response to Arguments

11. Applicant's arguments filed in the 5/13/03 Remarks have been fully considered but they are not persuasive because of the following:

(a) Wolff does not teach receiving a call, identifying the caller, selecting a suitable response, and communicating the response using a single portable terminal because Wolff utilizes multiple channel and facilities.

Examiner respectfully disagrees. With respect to receiving a call, the claimed limitation "a call coming to a potable terminal" is not the same as "receiving a call at a portable terminal". The disclosure teaches that CLI information is received at a portable terminal with respect to incoming calls and decisions are made on how to handle the call (Page 7, lines 1-10). In a similar manner, Wolff teaches receiving notifications (equivalent to CLI information) of incoming calls to a Laptop computer and decisions are made on how to handle the call (see Figure 4).

With respect to identifying the caller, the claimed limitation "the portable terminal identifies the caller on the basis of an identification information" is equivalent to Wolff's Laptop Laptop receiving notifications and displaying the caller information. This is because Wolff teaches it receives a message packet and displays the name and number of the caller (Col. 4, lines 33-37). It is clear from this teaching that Wolff has to "identify" the caller's name and

number in the message packet in order to display it. The arguments seem to suggest more that identifying the caller e.g. comparing and recognizing the caller but which were not claimed.

With respect to selecting a suitable response, the argument seems to suggest "selecting automatically a suitable response". The claim only recites "sending a reply by providing a selected response". The disclosure teaches that both user provided responses and automatic responses can be provided. Wolff teaches user provided selected responses (see Figure 4).

With respect to communicating the response using a single portable terminal, the argument appears to suggest that there are no intermediate processing steps. However, the disclosure teaches or suggests that reply messages are sent to callers from the portable terminal using different networks and protocols (Page 7, lines 1-10). This teaching suggests that replies are processed in the different networks before being sent to callers. In an equivalent way, a selected reply form Wolff's Laptop is processed by an exchange before being sent to a caller.

Finally, it can be seen that Applicant's arguments were not convincing and that Wolff performs all of the claimed functions through the portable Laptop.

(b) It is the portable terminal that establishes telephone communication and not the Platform 14 as is done in Wolff.

Examiner respectfully disagrees. As shown in Examiner's responses in (a) above, the portable telephone can select responses and answer calls. Wolff's portable Laptop can only select responses but not answer calls. However, the instructions to establish communications with a caller or sending a reply is performed by the Laptop computer (Figure 4). The claim does not recite answering a call by the portable terminal.

(c) Examiner respectfully believes that Applicant's arguments to portray Wolff's PTM 14 as the device meant by Examiner as the claimed portable terminal will be dispelled by Examiner's responses in (a)-(b) above.

(d) Examiner respectfully believes that the combination of Wolff with Villa-Real is proper for the same reasons given in (a)-(b) above.

(e) Examiner has noted Applicant's intention to consider a Terminal Disclosure after an indication of the allowability of the claims is received.

(f) Examiner respectfully invites Applicant to contact Examiner to discuss possible amendments for overcoming the prior art of record.

Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Metso et al. (US 5,920,826) teach a radiotelephone which receives and transmits messages over different networks.

LaPorta et al. (US 6,014,429) teach wireless terminals which send pre-recorded replies to callers.

Shirai (US 6,104,924) teaches a system and method for configuring mobile terminals with scripts for communication.

13. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

14. Any response to this final action should be mailed to:

Box AF
Commissioner of Patents and Trademarks
Washington, D.C. 20231

or faxed to:
(703) 872-9314, (for formal communications; please mark "EXPEDITED PROCEDURE")
Or:
(703) 306-0377 (for customer service assistance)

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington. VA., Sixth Floor (Receptionist).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Allan Hoosain** whose telephone number is (703) 305-4012. The examiner can normally be reached on Monday to Friday from 7 am to 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Fan Tsang**, can be reached on (703) 305-4895.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

Allan Hoosain

Allan Hoosain
Primary Examiner
7/18/03